

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:	)	Examiner: Wegert, Sandra
	)	
David BOTSTEIN, et al.	)	Art Unit: 1647
	)	
Application Serial No. 09/997,614	)	Confirmation No. 7398
	)	
Filed: November 15, 2001	)	Attorney's Docket No. GNE-2730 P1C29
	)	
For: <b>SECRETED AND</b>	)	<b>Customer No. 77845</b>
<b>TRANSMEMBRANE</b>	)	
<b>POLYPEPTIDES AND NUCLEIC</b>	)	
<b>ACIDS ENCODING THE SAME</b>	)	

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**FILED VIA EFS June 26, 2008**

**RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF**

**MAIL STOP APPEAL BRIEF - PATENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

On March 21, 2007, the Examiner made a final rejection to pending Claims 119-126 and 129-131. A Response to Final Office Action was filed on July 23, 2007 and a Notice of Appeal was subsequently filed on August 21, 2007. An Advisory Action was mailed on September 5, 2007. An Appeal Brief was filed on December 21, 2007. A Communication Re: Appeal was mailed March 28, 2008.

In response to the Communication Re: Appeal, in connection with the above-identified patent application, please consider the following arguments. This response is timely filed, with a request for a one month extension of time with necessary fees.

**Remarks/Arguments** begin on page 2 of this paper.

## **REMARKS**

A Communication Re: Appeal was mailed March 28, 2008, which stated that the Appeal Brief was not acceptable and asserted that "Appellant is required to submit a statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal."

Appellants respectfully disagree and submit that it is not necessary to provide any additional information for the following reasons. Appellants note that although there exist several applications directed to the "gene amplification" utility, in general, under Appeal, none of these are related to PRO1788 molecules or antibodies binding to it. As such, Appellants respectfully submit that although the issue in each case is "gene amplification utility," it is well established that each case is decided on its own facts and on the record of that case. Appellants submit that simply because one molecule has utility based on a particular biological assay does not mean that a different molecule necessarily has utility based solely on the legitimacy of that assay, other requirements have to be met under 35 U.S.C. §101. Accordingly, pending appeals concerning different molecules where gene amplification utility is an issue do not seem to qualify as "related to, directly affect or be directly affected by or have a bearing on the Board's decision" in another pending appeal.

Appellants further submit that it would impose an undue burden on Appellants to search for all patents and patent applications that rely on the gene amplification assay for utility, as the search for such a commonly used biological assay would produce an extremely large number of "hits" and many applications of its use may not be applicable to the utility of PRO1788.

### **CONCLUSION**

For the reasons given above, Appellants submit that the Appeal Brief is in compliance with 37 C.F.R. §41.37.

Accordingly, consideration of the previously submitted Appeal Brief for the above-identified application is respectfully requested.

Please charge any additional fees, including fees for additional extension of time, or credit overpayment to Deposit Account No. **07-1700** (referencing Attorney's Docket No. **123851-181895 (GNE-2730 P1C29)**).

Respectfully submitted,

Date: June 26, 2008

By:   
Christopher De Vry (Reg. No. 61,425)

**GOODWIN PROCTER LLP**  
135 Commonwealth Drive  
Menlo Park, California 94025  
Telephone: (650) 752-3100  
Facsimile: (650) 853-1038

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